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Robert Seseek

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EXAMINER
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LETT, THOMAS J

ART UNIT	PAPER NUMBER
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2625

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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***Reply Brief Noted***

1. The reply brief filed 09 January 2008 has been entered and a response by the Examiner is included in this Reply Brief. The instant application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

***Response to Arguments***

Applicant/Appellant submits this Reply Brief to respond to the new arguments/assertions made in the Examiner's Answer.

**1. Holding Plural Faxes And/Or Indicating The Receipt Of Plural Faxes Is Not Inherent In The Teachings of Nerlikar**

Claim 21 recites "the printer displaying a plurality of pending secured print jobs each having an authorized bio signature associated therewith." As noted in the Appeal Brief, Nerlikar describes only a single document faxed from secretary A to secretary B -- there is no plurality of pending print jobs in Nerlikar. The Examiner argues in response, apparently, that this element of Claim 21 is inherent in the single document teaching of Nerlikar. The Examiner states at page 9 of the Answer that:

*Examiner responds that Nerlikar can surely send and retrieve more than one secured document (or a plurality of faxed and retrieved secure documents) since fax machines are designed to send more than one communication (fax, document, image, etc.). Nerlikar merely describes a scenario/example of a single secure communication, but can definitely send more than one secure document. When a user sends more than one secure communication there will indeed be a plurality of prompts, alerts, or indications ... on the receiving end that secure documents are waiting for a certain recipient(s).*

The Examiner's argument is not correct. First, the Examiner's argument pre-supposes that Nerlikar's receiving fax machine is able to (1) hold plural incoming faxes for subsequent printing

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and (2) indicate that plural incoming faxes are being held for subsequent printing. Neither supposition is correct. Nerlikar describes only a single document faxed from secretary A to secretary B held at a buffer on the receiving fax machine until secretary B is recognized as the authorized recipient. Applicant does not concede that all fax machines available prior to February 2001 had the capability of holding plural incoming faxes for subsequent printing or that all fax machines had the capability of somehow indicating that plural incoming faxes were being held for subsequent printing. Nerlikar does not teach any such fax machine. Absent a further showing, the Examiner has failed to prove facts upon which he relies to support the obviousness rejection based on the combination of Nerlikar and Olsen.

Second, a receiving fax machine able to (1) hold plural incoming faxes for subsequent printing and (2) indicate that plural incoming faxes are being held for subsequent printing is not inherent in Nerlikar. To establish inherency, the Examiner must show that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. MPEP § 2112, paragraph IV. The Examiner has not, as yet, made any showing at all that the missing elements are necessarily present in the teachings of Nerlikar. Indeed, it seems clear that the method of Nerlikar will work just fine with a receiving fax machine that can handle only one incoming fax at a time. Thus, apart from the Examiner's failure to carry his burden of establishing inherency, a receiving fax machine able to (1) hold plural incoming faxes for subsequent printing and (2) indicate that plural incoming faxes are being held for subsequent is, in fact, not inherent in Nerlikar.

1. Examiner responds that Nerlikar clearly discloses a system that receives a secure document. A "secure document" is clearly defined by Nerlikar as any media containing **documents**, ...proprietary **documents**, personal **documents** or information, see at least col. 1, lines 13-19. Nerlikar's system sends more than one document and it follows that more than one document is received in the communication, see at least col. 1, lines 55-58. Examiner maintains that Nerlikar can surely send and retrieve more than one secured document (or a plurality of faxed and retrieved secure documents) since fax machines are designed to send more than one communication (fax, document, image, etc.). A fax machine can receive a five-page document, or 5 separate one-page documents. Nerlikar merely describes a scenario/example of a single secure communication, but can definitely send more than one secure document. When a user sends more than one secure communication there will indeed be a plurality of prompts, alerts, or indications on the receiving end that secure documents are waiting for a certain recipient(s). The fax message(s) of Nerlikar will be buffered at a server (col. 12, lines 16-18) or the facsimile machine's memory (col. 12, lines 16-18) and prompt(s) will indicate that message(s) are waiting. Applicant does not want to concede that more than one document can be stored in a memory or network server prior to 2001 but this was well-known in the art since servers and local memories have stored more than one document well before 2001. There is no implied restriction by Nerlikar of receiving a 400-page document or several one-page documents and buffering any of these communications in memory. Either of the 400-page, or the several one-page documents could be stored on a message server on the internet (for example) prior to 2001. The reason that it is inherent that there will be more than one prompt is because the system of Nerlikar is designed for multiple users with secure ID access. When a facsimile is sent for secretary B, and another for secretary C, there will inherently be a

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corresponding prompt for each secretary's corresponding fax document(s).

## 2. Olsen Only Displays Print Jobs The User Is Authorized To Print

The Examiner asserts in his Answer that Olsen teaches "[t]he user is allowed to select a print job from those that are displayed but cannot print or perform an operation on the print job until the user gets proper verification ..." This assertion is not correct. Olsen expressly teaches:

- a. A user may log on to the printing control system 100 according to the preferred embodiment of the present invention at any front-end module by introducing the user's card 132 into the card reader 130 and entering the user's pin code. The front-end module 124 subsequently verifies the user's identity by checking the pin code. If the pin code is not in accordance with the pin code registered in the server 136 for that particular user, then the display 126 informs the user that access is denied. **On the other hand if the pin code is in accordance with the pin code registered in the server 136 for that particular user, then the front-end module 124 requests print jobs from the control unit 120. However, only print jobs, which the particular verified user is allowed to perform.** The control unit 120 in turn requests this information from the server 136 checking the user table 114 in the job database 110. **The verified user may then view a document list, select to printing of any of the print jobs or viewing any of the print jobs on the display 126, which print jobs are designated to the verified user.** In case the verified user selects printing of a print job then the job database 110 communicates the print job through a connection 140 to a print engine 142. The print engine 142 enables the control unit 120 to upload the print job containing an secured and spooled data file through a connection 144 and subsequently enables the control unit 120 to further communicate the secured and

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spooled data file to the printer 116 so as to complete the print job. Olsen column 10, lines 36-62 (emphasis added).

Thus, in Olsen the only print jobs that are displayed are those that the "verified" user is authorized to print. That is to say, the act of verifying that the user is authorized to print a print job has already been completed as a prerequisite to the act of displaying the print job(s). In the method of Claim 21, by contrast, the act of comparing bio signatures is not a prerequisite to the act of displaying the print jobs. In fact, the act of comparing bio signatures in Claim 21 is performed after the act of displaying the print jobs. Again, even if the Examiner were to find a reference that teaches an Olsen type display at a printer, adding such a post-verification display to Nerlikar still does not yield all of the limitations in the method of Claim 21.

2. Examiner maintains that Olsen "displays a plurality of pending secured print jobs each having an authorized bio signature associated therewith" which is what the Applicant has claimed. Examiner focuses on the claim language and it is clear that the assertion by the Examiner is correct. As emphasized by Applicant's boldface of Olsen's disclosure: "**The verified user may then view a document list, select to printing of any of the print jobs or viewing any of the print jobs on the display 126, which print jobs are designated to the verified user.**" This clearly indicates that each of the displayed print jobs of the document list are those that the user is authorized to print based on the associated authentication of the user's credentials. Applicant has even stated above that "Thus, in Olsen the only print jobs that are displayed are those that the "verified" user is authorized to print."

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**Conclusion**

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is (571) 272-7464. The examiner can normally be reached on 8-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas J. Lett/  
Examiner, Art Unit 2625

/David K Moore/  
Supervisory Patent Examiner, Art Unit 2625